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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,621	07/27/2000	Conrad V. Anderson	55679USA2A.002	2487

32692 7590 05/20/2003

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EXAMINER

PURVIS, SUE A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 05/20/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/626,621

Applicant(s)

ANDERSON ET AL.

Examiner

Sue A. Purvis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Priority

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 34-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 34-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, 10, 12-20, 23, and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Krawczyk (US Patent No. 5,252,166) and Jensen, Jr. (US Patent No. 4,795,513).

Pages 1 and 2 of the instant specification teaches that previously a composite image was formed on the surface of a substrate manually by a skilled applicator who would pull or stretch each film slightly, thus varying its tension, as it was being applied to a maintain registration between the different panels used to form the composite image.

The admitted prior art does not teach using registration marks on the film and aligning those registration marks.

Krawczyk discloses a method of mounting multiple plastic sheets where the dimensions of the composite image are greater than the dimension of the plastic sheets. (Figures 17 and 18.) Each portion has guidelines thereon for which are used to help align the design properly.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include guides or registration marks in the method of the admitted prior

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art, because while in some instances a skilled artisan only needs to look at the composite image in order to align it properly images on separate sheets, there are instances where guidelines or registration marks would be helpful in aligning images on separate sheets as taught by Krawczyk.

The admitted prior art in view of Krawczyk does not teach varying the tension on the second film along the length of the film to help ensure the marks are aligned properly.

Jensen, Jr. teaches forming a two-layered composite, 16, formed by the lamination of paper web, 14, with film web, 12. The paper layer, 14, has a perforated pattern, 24, and the plastic layer, 12, has a target area, 28, positioned in registration with the area, 24. A register control system is adapted to provide proper registration between the perforated pattern, 24, and the target area, 28. During operation the length of the film web is stretched or shrunk in order for it to be properly aligned with the paper web. (Col. 7, lines 12-65).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the tension on the length second web thus stretching or shrinking the space between the registration marks, because Jensen, Jr. teaches such steps are known ways of aligning webs.

Regarding claim 2, applicant sets out in claim 1, that the second film is dispensed “under tension along the length of the second film”; claim 2 states that this tension is “continuously applied to the second film during dispensing.” As a film is dispensed “under tension”, it seems to the examiner that tension must be applied continuously for the “length” of the film to be under tension as stated in claim 1. This is shown in Jensen and admitted in the applicant’s art. When a film is dispensed or applied to a substrate, it must be so under a certain amount of tension,

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otherwise the film would become loose and bunch when adhered to another sheet, thus resulting in an undesirable outcome. Applicants own art admits a manual tensioning means, Jensen also has a tensioning means as shown in Figure 1 of Jensen. The webs are fed around cylinders (not numbered) which helps to maintain tensioned web, then through nip (62) which engages the web and varies the rate of transfer, thus controlling the tension in the web.

Regarding claim 3, Krawczyk and Jensen disclose using reference marks for alignment purposes.

Regarding claims 4 and 5, reference marks must be visible in order to allow for proper alignment and aligning the reference marks of the two films is done in Krawczyk and Jensen.

Regarding claim 6, it is within the purview of the artisan to remove registration marks if the artisan desires fewer reference marks. It is also preferable to an artisan to have reference marks which are not seen or at least hardly noticed in the final product. In Krawczyk, one embodiment discusses how the guidelines or reference lines are easily removable because they are made with an erasable marker. (Col. 16, lines 43-47). The artisan has no desire for the marks created for the sole purpose of lining up sheets of material to be noticed after installation is complete, thus they would either make the references so small that they are barely noticeable or have the capability of removing mark, as shown in Krawczyk.

Regarding claims 7 and 24, when joining two films together the films are stretched so that the registration marks line up, as a result one film may have a bit of excess which would result in removing a portion of the film along with the registration marks thereon. There could be a number of reasons for such an occurrence, such as one film's supply is greater than the other or the supply appears to be the same at first but by stretching the film to line up the references

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marks, the stretched film ends up having excess film. Another possibility is that the film is removed for the sole purpose of removing the reference marks, and this is an obvious alternative to washing off the reference marks and is also shown in Krawczyk. The pelican design in Figure 18 shows the design with the top sheets attached, the top sheets contain the guidelines. Once the adhesive is hardened, those top sheets are removed, thus the guidelines are removed. Thus, it is the position of the examiner that to remove part of the sheet to remove the registration marks is within the purview of the artisan. This is also shown in a Hensley et al. (US Patent No. 6,354,984 B1) where reference marks are preferably confined inside trim areas (79) such that the cutting out of a respective trim area simultaneously (i) creates a desired new element of the work piece, namely the leg cut-out, and (ii) removes the reference mark which was used to register the graphic to the pad. (See Figures 3, 4, and 6; Col. 16, lines 65-68.)

Regarding claims 10 and 12, invisible and washable registration marks are within the purview of one having ordinary skill in the art, because it would be preferable that the alignment marks not be intrusive to the composite image. Krawczyk discloses washable reference marks as mentioned above.

Regarding claim 13, Krawczyk shows the use of a liner and having a film attached to a liner, especially where one side of the film is adhesive is within the purview of one having ordinary skill in the art. The liner prevents the film from adhering to undesirable objects.

Regarding claim 14, it is within the interests of the artisan to distribute the reference marks in regular intervals. The other option being irregular intervals which would not serve the purpose the artisan had designed the registration marks for. This is introduced in the applicant's own admitted prior art as well as in Krawczyk and Jensen. (See Figure 2 of Jensen.)

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Regarding claim 15, storing film on a roll is well known and conventional as seen in Jensen.

Regarding claim 16, the reference marks would act as orientation indicators since they enable the films to line up properly.

Regarding claim 17, a direct result of aligning the reference marks is the alignment of the portions of the composite image. The admitted prior art uses just the composite image for this alignment while Krawczyk and Jensen show that registration marks are another way of achieving the same result. Thus, the alignment of the registration marks of the admitted prior art in view of Krawczyk and Jensen would result in the composite image being aligned and registered across the width of the film.

Regarding claim 18, Jensen teaches control means that detects the distances between the reference marks in order to ensure the film is lined up properly. In determining the distance, as a result the “distance between a leading edge and a trailing edge” of the marks is found. Furthermore, since the web is in tension across its width, that distance is indicative of the position of the composite image across the width of the web, to be otherwise would mean that one side of the web is stretched while the other being relaxed, thus creating a skewed web.

Regarding claim 19, applicant’s own admitted prior art states the skilled applicator will stretch or pull each film slightly as it is applied to the substrate in order to maintain registration between the different film panels.

Regarding claim 20, it is noted the film in Jensen, Jr. is fed in roll form, furthermore typically wallpaper or carpet, items which are applied to a static structure such as the instant invention, are typically stored in roll form.

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3. Claims 8 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Krawczyk and Jensen as applied to claims 1, 5-7, 23, and 24 above, and further in view of Shannon (US Patent No. 4,806,184) or Fritz (US Patent No. 1,498,618).

Admitted prior art in view of Krawczyk and Jensen does not show removing the film before it is applied to the substrate is a matter of choice and within the purview of one of ordinary skill in the art. The choices are before or after and the artisan would know when it is preferable to remove any excess. Mitchell (US Patent No. 4,490,198) shows the excess material being trimmed after it is applied to the substrate. In particular, however, Shannon discloses that the material is cut to the desired length before application to the substrate. Fritz, mentioned in Shannon, also teaches to cut the sheet before applying to a substrate.

It would have been obvious to one having ordinary skill in the art at the time the invention was made when the film should be cut, because Shannon and Fritz both teach the film being trimmed before applying the film to the substrate. Thus to do so is within the purview of the artisan.

4. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Krawczyk and Jensen as applied to claims 1 above, and further in view of Easter (US Patent No. 4,620,888) or Roch (US Patent No. 5,138,667).

The admitted prior art uses the visible images for alignment purposes, Krawczyk, as discussed above, uses marks which are washable, so that they do not later interfere with the images. The marks (19) in Jensen are visible to the photoelectric eye (52). (Col. 7, lines 7-10).

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Registration marks, such as those in Jensen, are designed to be unnoticed to the ordinary observer. This is further shown in Easter and Roch where the marks are “invisible”. See claim 3 of Roch and column 5, lines 60-68 of Easter.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use invisible marks for registration purpose of both first and second films, because as shown in Easter and Roch these types marks are known and used in the art. They are used to align materials without interfering with the overall appearance.

5. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Krawczyk and Jensen as applied to claims 1 above as applied to claim 1 above, and further in view of Shannon (US Patent No. 4,806,184).

A length of 5 meters and 10 meters is within the purview of one having ordinary skill in the art. The admitted prior art states 3 meters, however an artisan would know that the longer the length of the web, the less likely two webs will need to be used to cover a single surface and less chance for improper alignment. Shannon discloses a wallpaper applicator. Wallpaper is applied to rooms of varying sizes. As shown in Figure 14 of Shannon, the wallpaper is fed from a roller and placed side by side. This length of the material on the roll is not disclosed, but considering how the material is used in Shannon, it is the position of the examiner that the roll of material is more than 3 meters, because it is reused and an artisan would optimize the use of the device by making the roll as large as possible, thus minimizing the time it would take to refill the roll. Furthermore, the image on the wallpaper in Shannon is aligned as seen Figure 14.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the film as long as the skilled artisan needed for the purpose so

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desired. For instance, Shannon's supply is greater than the surface covered and the material along with the image is aligned. Methods which utilize a longer film, although not for aligning as in the instant invention, are Cousineau (US Patent No. 6,024,821) and Siker (US Patent No. 4,049,479). These references are only pulled to show that using a continuous sheet with an image thereon is known in the art.

6. Claims 34-37, 39, and 41-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Krawczyk, Shannon, and Jensen.

Pages 1 and 2 of the instant specification teaches that previously the composite image was formed on the substrate by manually adhering the films to the substrate using a pressure sensitive adhesive. An applicator starts at the top of each film and works toward the bottom. The films are laminated to the substrate using manual pressure applied with a squeegee-like device. A skilled applicator would pull or stretch each film slightly, thus varying its tension, as it was being applied to maintain registration between the different panels used to form the composite image.

The admitted prior art does not teach using registration marks on the film and aligning those registration marks.

Krawczyk discloses a method of mounting multiple plastic sheets where the dimensions of the composite image are greater than the dimension of the plastic sheets. (Figures 17 and 18.) Each of the sheets with a portion of the composite image thereon also has guidelines which are detected and used to help align the composite image properly.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include guides or registration marks in the method of the admitted prior

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art, because while in some instances a skilled artisan only needs to look at the composite image in order to align it properly images on separate sheets, there are instances where guidelines or registration marks would be helpful in aligning images on separate sheets as taught by Krawczyk.

The admitted prior art in view of Krawczyk does not discuss inducing a constant stretch to the first film or teach varying the tension on the second film along the length of the film to help ensure the registration marks of the first and second films are aligned properly.

Shannon discloses a handheld wallpaper applicator. The reference is of interest because it discusses applying a material (M) to a substrate and aligning that material (M) to a second material already on the substrate. (See Figure 14.) In applying the material, the applicator allows the user to applying a constant tension to the along the length of the material as it is applied to the substrate. (Col. 7, lines 16-56; Col. 8, lines 19-30.)

Jensen, Jr. is of interest because it teaches using a register control system adapted to provide proper registration between the two films. During operation the length of the film web is stretched or shrunk in order for it to be properly aligned with the paper web. (Col. 7, lines 12-65).

It would have been obvious to one having ordinary skill in the art at the time the invention was made based on the teaching of Shannon to induce a constant tension or stretch in the first film of the admitted prior art in view of Krawczyk, because in applying the first film to the substrate it is within the purview of the artisan to know that the film needs to be under tension to result in a smooth surface. Furthermore, both Jensen and Shannon teach that it is within the purview of the artisan to vary the tension on the length second web so the webs line

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up properly. In Shannon, the images of the second substrate need to line up with the images of the first substrate. In Jensen, two webs are aligned. While this aligning is not done on the substrate, it is within the purview of the artisan to apply the teaching in Jensen that shows stretching or shrinking the space between the registration marks to align the webs.

Regarding claim 35, it is within the purview of the artisan to remove registration marks if the artisan desires fewer reference marks. It is also preferable to an artisan to have reference marks which are not seen or at least hardly noticed in the final product. In Krawczyk, one embodiment discusses how the guidelines or reference lines are easily removable because they are made with an erasable marker. (Col. 16, lines 43-47). The artisan has no desire for the marks created for the sole purpose of lining up sheets of material to be noticed after installation is complete, thus they would either make the references so small that they are barely noticeable or have the capability of removing mark, as shown in Krawczyk.

Regarding claim 36, when joining two films together the films are stretched so that the registration marks line up, as a result one film may have a bit of excess which would result in removing a portion of the film along with the registration marks thereon. There could be a number of reasons for such an occurrence, such as one film's supply is greater than the other or the supply appears to be the same at first but by stretching the film to line up the references marks, the stretched film ends up having excess film. Another possibility is that the film is removed for the sole purpose of removing the reference marks, and this is an obvious alternative to washing off the reference marks and is also shown in Krawczyk. The pelican design in Figure 18 shows the design with the top sheets attached, the top sheets contain the guidelines. Once the adhesive is hardened, those top sheets are removed, thus the guidelines are removed. Thus, it is

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the position of the examiner that to remove part of the sheet to remove the registration marks is within the purview of the artisan.

Regarding claims 37 and 44-46, Shannon discloses that the material (M) is cut to the required length sufficient to cover the surface before the material is applied to the substrate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to cut the material in the admitted prior art to a length sufficient to cover the surface before the film is applied to the substrate as taught in Shannon, because when a material is supplied in a length excess to what is needed by the artisan it is within the purview of the artisan to cut it before applying it to the substrate. In the alternative, the artisan can apply the film to the substrate, cut the excess film off at the end, and not apply that portion to the substrate. In the discussion of the prior art, Shannon mentions a device which includes a cutter thereon. (Col. 1, lines 57-66.)

Regarding claims 39 and 41, washable registration marks are within the purview of one having ordinary skill in the art, because it would be preferable that the alignment marks not be intrusive to the composite image. Krawczyk discloses washable reference marks as mentioned above.

Regarding claims 42, 43, and 47, Jensen teaches control means that detects the distances between the reference marks in order to ensure the film is lined up properly. In bringing this teaching into the admitted prior art, the same would be true. Furthermore, as films are laid onto a substrate, they are laid down smoothly across the width of the film. To do so otherwise would result in a film being laid down improperly and likely wrinkled or skewed. On page 7 of the specification, it is disclosed that the film is steer based of the measurements of the distance

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between the leading and trailing edges of the registration marks, however, applicant has not claimed that here. The applicant states to steer “the second film to register...in a direction transverse to the length...” When the film is laid across a substrate, it is steered in a direction transverse to its length as required by these claims.

7. Claims 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Krawczyk, Shannon, and Jensen as applied to claim 34 above, and further in view of Easter (US Patent No. 4,620,888) or Roch (US Patent No. 5,138,667).

The admitted prior art uses the visible images for alignment purposes, Krawczyk, as discussed above, uses marks which are washable, so that they do not later interfere with the images. The marks (19) in Jensen are visible to the photoelectric eye (52). (Col. 7, lines 7-10).

Registration marks, such as those in Jensen, are designed to be unnoticed to the ordinary observer. This is further shown in Easter and Roch where the marks are “invisible”. See claim 3 of Roch and column 5, lines 60-68 of Easter.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use invisible marks for registration purpose of both first and second films, because as shown in Easter and Roch these types marks are known and used in the art. They are used to align materials without interfering with the overall appearance of material.

Response to Arguments

8. Examiner disagrees that the proposed combination would change the principle operation of the prior art being modified. The applicant’s admitted prior art discloses that previously the composite image was formed on the substrate by manually adhering the films to the substrate

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using a pressure sensitive adhesive whereby a skilled applicator would pull or stretch each film slightly as it was being applied to a maintain registration between the different panels used to form the composite image. It is within the purview of the artisan to look to the secondary reference, Krawczyk, to see that registration marks can be used to align the images on material. It does not change the principle operation of the admitted prior to add registration marks to the films which are applied to the substrate. Instead of a user manually aligning the composite image, the user will manually align the registration marks and as a result, the composite image will be aligned. Furthermore, the tertiary reference, Jensen, teaches that aligning registration marks between webs can be automated. This also does not change the principle of operation of the prior art being modified. In applying the teachings of Jensen to the admitted prior art in view of Krawczyk, the reference may be bodily incorporated into the structure of the primary reference, it is the teaching of detecting the various registration marks on the two webs and aligning those marks that the examiner is relying on in the rejection.

9. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

10. Regarding applicant's arguments with respect to claim 2, the applicant asserts the admitted prior art states that tension is sporadically applied in a variety of directions, however,

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this is not consistent with the applicant's disclosure. The admitted prior art states the applicator uses a squeegee-like device to apply the film, stretching and pulling the film slightly to maintain registration between the different panels to form composite images. No mention is made that the films are pulled in a variety of directions. When placing a film on a surface and aligning it along the length of another film, the length is varied in order to achieve that alignment. Assuring the film is pressed smoothly onto the surface properly aligns the width of the film. (See Shannon.)

11. Regarding applicant's arguments with respect to claims 6, 10, and 12, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Here, the applicant argues that Krawczyk teaches removing registration marks from a tile, not a film as recited in the claims. It is the general teaching in Krawczyk of removing the registration marks that the examiner has relied in rejecting this claim. It does not matter that Krawczyk removes the marks from tiles, it is within the purview of the artisan to apply that teaching to the admitted prior art, which deals with film. The same is true regarding the washable marks in Krawczyk.

12. Regarding applicant's arguments with respect to claim 18, Jensen teaches control means that detects the distances between the reference marks in order to ensure the film is lined up properly. In bringing this teaching into the admitted prior art, the same would be true. Furthermore, as films are laid onto a substrate, they are laid down smoothly across the width of the film. To do so otherwise would result in a film being laid down improperly and likely

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wrinkled or skewed. On page 7 of the specification, it is disclosed that the film is steer based of the measurements of the distance between the leading and trailing edges of the registration marks, however, applicant has not claimed that in this claim. Here, the applicant merely states that the “distance is indicative of a position across the width of the film.”

13. Regarding applicant’s arguments with respect to claim 19, the admitted prior art teaches the films are laminated to the substrate using manual pressure applied with a squeegee-like device. A skilled applicator would pull or stretch each film slightly, thus varying its tension, as it was being applied to a maintain registration between the different panels used to form the composite image. The first film has to be under tension in order to be applied to the substrate properly. This is also shown in Shannon. It is unlikely an artisan would want a film to be loosely applied to the substrate. This would result in the film not being aligned properly with subsequent films which are applied under tension.

14. Regarding applicant’s arguments with respect to claims 7 and 24, when joining two films together the films are stretched so that the registration marks line up, as a result one film may have a bit of excess which would result in the user removing the excess portion of the film along with the registration marks thereon. There could be a number of reasons for such an occurrence, such as one film’s supply is greater than the other or the supply appears to be the same at first but by stretching the film to line up the references marks, the stretched film ends up having excess film. In addition, Hensley was not relied on in rejecting these claims, but merely as a teaching reference to show removing a portion of the second film is within the purview of the artisan.

15. Regarding applicant’s arguments with respect to claims 8 and 25, these claims do not require that all the registration marks be removed from the film. In fact, claim 8 depends from

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claim 7 which depends from claim 6 which requires only some of the registration marks be removed from the film. From the claims, the examiner has interpreted that only some of the registration marks are removed and thus registration between the two films can still be accomplished. Furthermore, Jensen, as tertiary reference, is not contradicted by this step. It is the combination of references that the examiner has relied on in rejecting these claims. As for Shannon and Fritz, both of these references teach to cut a web to a desired length before applying it to a substrate. If that web were to contain reference marks, then reference marks are removed as required by claims 8 and 25. Mitchell shows a general well-known teaching as discussed above and was not relied for the rejection.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

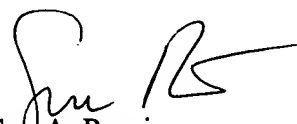
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is 703-305-0507. The examiner can normally be reached on Monday through Thursday 8am to 5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rick Crispino can be reached on 703-308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-1495.



Sue A. Purvis
Examiner
Art Unit 1734

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May 17, 2003



RICHARD CRISPINO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700